

REMARKS

Status of Claims:

Claims 1-12 are present for examination.

Foreign Priority:

The Examiner marked boxes 12) and 12) a) of the Office Action Summary of the present Office Action to indicate acknowledgement of a claim for foreign priority. Applicant believes that box 12) a) 1) should also have been marked by the Examiner to acknowledge that certified copies of the priority documents have been received.

Thus, applicant requests that the Examiner acknowledge receipt of the certified copies of the priority documents.

Claim Rejections under 35 U.S.C. 112:

Claims 5-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

With respect to claims 5-12, as amended, the rejections are respectfully traversed.

The Examiner stated that, “[c]laim 5 is indefinite because it is a mixed class claim”. Claim 5 has been amended so that the preamble recites an advertisement display method and the body of the claim recites method steps. Therefore, independent claim 5, as amended, is believed to be in compliance with the requirements of 35 U.S.C. 112, second paragraph.

The Examiner stated that, “[c]laim 7 is indefinite because it is a mixed class claim”. Claim 7 has been amended so that the preamble recites an advertisement display method and the body of the claim recites method steps. Therefore, independent claim 7, as amended, is believed to be in compliance with the requirements of 35 U.S.C. 112, second paragraph.

The Examiner stated that, “[c]laim 9 is indefinite because it is a mixed class claim”. Claim 9 has been amended so that the preamble recites a storage medium storing an advertisement display program for causing a computer to execute a process, and the body of

the claim recites process steps. Therefore, independent claim 9, as amended, is believed to be in compliance with the requirements of 35 U.S.C. 112, second paragraph.

The Examiner stated that, “[c]laim 11 is indefinite because it is a mixed class claim”. Claim 11 has been amended so that the preamble recites a storage medium storing an advertisement display program for causing a computer to execute a process, and the body of the claim recites process steps. Therefore, independent claim 11, as amended, is believed to be in compliance with the requirements of 35 U.S.C. 112, second paragraph.

The dependent claims are believed to be in compliance with the requirements of 35 U.S.C. 112, second paragraph, for at least the same reasons indicated above with regard to the independent claims from which they depend.

Claim Rejections under 35 U.S.C. 101:

Claims 5-12 are rejected under 35 U.S.C. 101 as being directed to two different statutory classes of invention.

With respect to claims 5-12, as amended, the rejections are respectfully traversed.

The Examiner stated that claim 5 “is directed to two different statutory classes of invention.” Claim 5 has been amended to make is clear that the claim is directed to a method. Therefore, independent claim 5, as amended, is believed to be in compliance with the requirements of 35 U.S.C. 101.

The Examiner stated that claim 7 “is directed to two different statutory classes of invention.” Claim 7 has been amended to make is clear that the claim is directed to a method. Therefore, independent claim 7, as amended, is believed to be in compliance with the requirements of 35 U.S.C. 101.

The Examiner stated that claim 9 “is directed to two different statutory classes of invention.” Claim 9 has been amended to make is clear that the claim is directed to a storage medium storing an advertisement display program for causing a computer to execute a

process. Therefore, independent claim 9, as amended, is believed to be in compliance with the requirements of 35 U.S.C. 101.

The Examiner stated that claim 11 “is directed to two different statutory classes of invention.” Claim 11 has been amended to make is clear that the claim is directed to a storage medium storing an advertisement display program for causing a computer to execute a process. Therefore, independent claim 11, as amended, is believed to be in compliance with the requirements of 35 U.S.C. 101.

The dependent claims are believed to be in compliance with the requirements of 35 U.S.C. 101 for at least the same reasons indicated above with regard to the independent claims from which they depend.

Claim Rejections under 35 U.S.C. 103(a):

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen (U.S. Patent Number 6,236,330). Also, the Examiner takes Official Notice that both the concepts and the advantages of the “cancel registration” elements and limitations of claim 2 and the “terminal sends cancel information” elements and limitations of claim 4 were notoriously well known and expected in the art at the time of the invention.

With respect to claims 1-12, as amended, the rejection is respectfully traversed. Applicant also respectfully traverses the taking of Official Notice and holds the Examiner to strict proofs thereof.

Independent claim 1, as amended, recites an advertisement system comprising:

“a portable telephone communication terminal capable of communicating with other portable telephone communication terminals utilizing a display on said portable telephone communication terminal, and capable of displaying an advertisement on said display when said display is operating in a standby mode;

a terminal management device for managing said portable telephone communication terminal; and

an advertisement broadcast device for storing advertisement data provided by an advertisement broadcaster,

wherein said terminal management device comprises:

notification means for, when a registration request including first information representing that said portable telephone communication terminal is an advertisement display terminal and second information representing an advertisement broadcaster designated by said portable telephone communication terminal is issued by said portable telephone communication terminal, notifying said advertisement broadcast device of the registration request including the first information in accordance with the second information,

registration means for registering the first information and the second information when said advertisement broadcast device sends registration acceptance in response to the registration request notification from said notification means, and

display control means for, when advertisement data is received from said advertisement broadcast device which is a registration acceptance notification source, transmitting the received advertisement data to said portable telephone communication terminal on the basis of the registered first information and the registered second information, and displaying the advertisement data on the display of said portable telephone communication terminal when said display is operating in said standby mode." (Emphasis Added).

An advertisement system including the above-quoted features has at least the following advantages: (1) advertisement data can be displayed on a display of a portable telephone communication terminal; (2) the portable telephone communication terminal is capable of communicating with other portable telephone communication terminals utilizing the display; (3) the advertisement data is displayed on the display when the display is operating in a standby mode; and (4) an advertisement broadcast device is notified of a registration request from the portable telephone communication terminal so that the user of the portable telephone communication terminal can decide whether to automatically display advertisement data on the display. (Specification; page 1, lines 6-14; page 4, line 25 to page 5, line 8; page 17, line 19 to page 18, line 5).

Cohen neither discloses nor suggests an advertisement system including the above-quoted features for at least the following five reasons.

First, Cohen neither discloses nor suggests a system in which advertisement data is displayed on a display of a portable telephone communication terminal. The system of Cohen employs billboard display panels such as those supported by a single pole, or that are free standing such as an easel or tripod, or that are carried such as a sandwich board, or that are secured to a roof of an automobile or mounted across the front, sides, or rear of a truck, bus, or trailer. (Cohen; column 1, lines 61-62; column 3, lines 59-65). The list of display panels discussed in Cohen include only those types of displays that have historically been used for reliably displaying advertisement messages, and only improves on the historic uses by allow messages to be displayed based on location and time. Indeed, in a section of background history, Cohen lists historical examples of mobile displays including a person wearing a sandwich board, an ice cream vendor's truck with an illustration of an ice cream popsicle, trucks indicating the source of their contents, taxi, bus, railroad, and subway car billboards, buses wrapped in electrostatic marking film, and cargoless vehicles carrying billboards. (Cohen; column 1, lines 17-27).

In contrast, an advertisement system including the above-quoted features opens up a whole new potential advertising space for advertisers that has not previously existed. As discussed in applicant's specification (page 1, line 15 to page 2, line 2), there has been no previously know method for reliably displaying advertisement data on a display of a portable telephone that allows for the advertisement to be displayed automatically without a user having to open a file such as a mail message.

Also, portable telephones are a unique type of advertisement space because they are carried closely by the intended target audience of the advertisement messages and, thus, the advertisement broadcaster can realize a great advertisement effect. (Applicant's specification; page 17, line 19 to page 18, line 1). Furthermore, because portable telephones are personal to the telephone users that are the targets of the advertisements, there is a possibility to provide new types of incentives to get users to display the advertisements. For example, an advertisement broadcaster may bear part of a communication charge of a terminal user and may bear part of the telephone terminal cost so that the telephone user can

expect a discount on communication charges and can get a telephone terminal at a low cost. (Applicant's specification; page 18, lines 1-5).

Second, Cohen neither discloses nor suggests a system in which an advertisement is displayed on a display of a portable telephone communication terminal where the portable telephone communication terminal is capable of communicating with other portable telephone communication terminals utilizing the display. In the system of Cohen, a controller may communicate with a network of fixed location stations that provide programming data, message content, and scheduling data. (Cohen; column 2, lines 8-12; column 4, lines 23-26 and lines 33-36). However, Cohen neither discloses nor suggests that the fixed location stations allow the controller to communicate with other controllers. Furthermore, the billboard display panels of the system of Cohen are not even utilized to make communication with the fixed location stations. The displays in the system of Cohen only display programmed advertisement data and are not used by the controllers of Cohen when performing communication with the fixed location stations. (Cohen; column 3, line 53 to column 4, line 16).

Third, as recognized by the Examiner, Cohen lacks explicit recitation of a standby screen. The Examiner states that, "it would have been obvious to one of ordinary skill in the art at the time of the invention that Cohen at least (FIG. 3; and FIG. 1) implicitly shows: 'a standby screen...'" However, Cohen does not implicitly show a standby screen, because the billboard display panels in the system of Cohen only have a single purpose, which is to display advertisement messages. (Cohen; column 1, line 61 to column 2, line 5; column 4, lines 3-6). Thus, when the advertisements are displayed on the billboard display panels of the system of Cohen, the display panels are not in a standby mode, but rather are in a full operational mode, because that is the only operation that the display panels in Cohen provide. In contrast, with an advertisement system including the above-quoted features, a display of a portable telephone communication terminal is capable of performing functions other than displaying advertisements, and only when it is not performing those other functions is the display in a standby mode.

Fourth, in an advertisement system including the above-quoted features, a target for an advertisement is an owner of a portable telephone communication terminal since advertisement data is displayed on a standby screen of the portable telephone communication terminal. In contrast, with the system of Cohen, the target audience is a large number of people besides an owner of the billboard display panels, since advertisement data is displayed on one or more moveable billboard displays moved by a transporter and intended to advertise to a large audience.

Fifth, in the system of Cohen, an advertisement broadcast device is not notified of a registration request from the display or controller including first information representing that the display is an advertisement display terminal and second information representing an advertisement broadcaster designated by the display or controller. Indeed, there would be no reason for the display in the system of Cohen to send a registration request including first information representing that the display is an advertisement display terminal, because the display is only an advertisement display terminal. (Cohen; column 1, line 61 to column 2, line 5; column 4, lines 3-6). Also, the display in the system of Cohen is controlled by scheduling data that is dictated by a fixed location station, and the display is operated according to the dictated schedule. (Cohen; column 4, lines 33-42). In contrast, with an advertisement system including the above-quoted features, a registration request from a portable telephone communication terminal is effective because a user can use his/her terminal to set whether to automatically display an advertisement on his/her terminal. (Applicant's specification; page 5, lines 5-8).

Therefore, independent claim 1, as amended, is neither disclosed nor suggested by the cited prior art and, hence, is believed to be allowable.

Dependent claim 2, as amended, recites the system according to claim 1,

“wherein when a registration cancel request for said portable telephone communication terminal is issued, said registration means cancels registration of the first information and the second information, and said notification means notifies said

advertisement broadcast device of cancellation of registration of said portable telephone communication terminal.” (Emphasis Added).

Claim 2 depends from independent claim 1 and, thus, is believed to be allowable for at least the same reasons indicated above with respect to claim 1. In addition, claim 2 provides the further distinction that a registration cancel request for a portable telephone communication terminal can be issued.

The Examiner recognizes that, “Cohen lacks explicit recitation of the ‘cancel registration’ element of claim 2”. The Examiner then states that, “Official Notice is taken that both the concepts and advantages of the ‘cancel registration’ elements and limitations of claim 2 were notoriously well known and expected in the art at the time of the invention, and it would have been obvious to a person of ordinary skill in the art at the time of the invention to modify and interpret the disclosure of Cohen cited above as showing all of the elements and limitations of claim 2”. The Official Notice taken by the Examiner is respectfully traversed.

It would not have been obvious to modify the display or controller in the system of Cohen to provide a registration cancel request, because the display in Cohen is controlled by programming data and scheduling data from fixed location stations. (Cohen; column 4, lines 33-42). Indeed, in the system of Cohen, instructions may be provided from the station to a transporter with the display where the specific instructions instruct a desired location, schedule of times and locations, and programming instructions for message content. (Cohen; column 4, line 67 to column 5, line 4). Thus, in Cohen, the controller receives instructions from the station and there is no motivation for the display to provide a cancellation request because the whole purpose of the display is to display the content from the station.

Therefore, dependent claim 2, as amended, is neither disclosed nor suggested by the cited prior art and, hence, is believed to be allowable.

Independent claim 3, as amended, recites an advertisement system comprising:

“a portable telephone communication terminal capable of communicating with other portable telephone communication terminals”

utilizing a display on said portable telephone communication terminal, and capable of displaying an advertisement on said display when said display is operating in a standby mode;

a terminal management device for managing said portable telephone communication terminal;

a server which is connected to the Internet and has a plurality of advertisement pages that store advertisement data; and

an advertisement management device for managing each advertisement page of said server,

wherein said advertisement management device has registration means for registering URLs of said plurality of advertisement pages of said server in said terminal management device, and

said terminal management device comprises:

search means for, when said portable telephone communication terminal sends a particular URL of an Internet page, searching said URLs registered by said registration means for the particular URL,

notification means for notifying said advertisement management device of the particular URL when said search means finds the particular URL,

transmission means for, when said advertisement management device sends back registration acceptance in response to the notification from said notification means, transmitting a registered URL for the particular URL to said portable telephone communication terminal,

request means for, when a transmission request for advertisement data of an advertisement page corresponding to the registered URL is received from said portable telephone communication terminal in response to transmission of the registered URL, requesting transmission of the advertisement data corresponding to the registered URL of said server, and

display control means for, when the advertisement data is received from said server in response to the advertisement data transmission request, transmitting the received advertisement data to said portable telephone communication terminal, and displaying the advertisement data on the display of the portable telephone communication terminal when said display is operating in said standby mode." (Emphasis Added).

An advertisement system including the above-quoted features has similar advantages as advantages of the advertisement system of independent claim 1 in that with the

advertisement system including the above quoted features: (1) advertisement data can be displayed on a display of a portable telephone communication terminal; (2) the portable telephone communication terminal is capable of communicating with other portable telephone communication terminals utilizing the display; and (3) the advertisement data is displayed on the display when the display is operating in a standby mode. Therefore, independent claim 3 is believed to be allowable for at least the same reasons indicated above in the first through fourth arguments with respect to claim 1.

In addition, an advertisement system including the above-quoted features has at least the additional advantage that: (4) when a portable telephone communication terminal sends a particular URL of an Internet page, a search means searches registered URLs for the particular URL, and if the particular URL is registered, advertisement data related to the URL can be displayed on a display of the portable telephone communication terminal. Thus, the portable telephone communication terminal can select a particular URL from which advertisement data is to be obtained. (Applicant's specification; page 13, line 5 to page 15, line 13).

Cohen neither discloses nor suggests an advertisement system including the above-quoted features. In Cohen, an advertiser 28 may access a station via a communications link 29, e.g. on-line through a modem to a website for message content and scheduling. (Cohen; FIG. 4; column 5, lines 5-8). However, the advertiser 28 in the system of Cohen is not the display 14. (Cohen; FIG. 4). Cohen neither discloses nor suggests that the display 14 sends a particular URL of an Internet page. Indeed, the display 14 and controller 16 in the system of Cohen receive programming data and display message content data from one of the fixed location stations 20, 22, 24 where the data are dictated by the stations, and the display and controller do not transmit a particular URL. (Cohen; column 4, lines 33-38).

Therefore, independent claim 3, as amended, is neither disclosed nor suggested by the cited prior art and, hence, is believed to be allowable.

Independent claim 5 recites an advertisement display method with similar features as features of the advertisement system of independent claim 1. Therefore, independent claim 5

is believed to be allowable for at least the same reasons that independent claim 1 is believed to be allowable.

Independent claim 7 recites an advertisement display method with similar features as features of the advertisement system of independent claim 3. Therefore, independent claim 7 is believed to be allowable for at least the same reasons that independent claim 3 is believed to be allowable.

Independent claim 9 recites a storage medium storing an advertisement display program for causing a computer to execute a process with similar features as features of the advertisement system of independent claim 1. Therefore, independent claim 9 is believed to be allowable for at least the same reasons that independent claim 1 is believed to be allowable.

Independent claim 11 recites a storage medium storing an advertisement display program for causing a computer to execute a process with similar features as features of the advertisement system of independent claim 3. Therefore, independent claim 11 is believed to be allowable for at least the same reasons that independent claim 3 is believed to be allowable.

The dependent claims are deemed allowable for at least the same reasons indicated above with regard to the independent claims from which they depend.

Conclusion:

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a

check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date May 2, 2005

By Justin M. Sobaje

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (310) 975-7965
Facsimile: (310) 557-8475

Justin M. Sobaje
Attorney for Applicant
Registration No. 56,252